

REMARKS

I. STATUS OF THE CLAIMS

Claims 38-106 are pending. Claims 59, 61-68, 70-77, 80-82, and 85-87 are withdrawn from consideration because they are directed to non-elected subject matter. No claim amendments are made in this Response.

II. DOUBLE PATENTING REJECTION

The Examiner maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under the judicially created doctrine of obviousness-type double patenting over claims 1-41 of U.S. Patent No. 6,346,234 to Rollat et al. ("the '234 patent"), in view of EP 0551 749 to Lee et al. ("*Lee*") for the reasons of record. Office Action, pages 2-3. Applicants continue to disagree with the Examiner for the reasons of record. However, solely to advance the prosecution of the present application, Applicants respectfully direct the Examiner's attention to the Terminal Disclaimer filed concurrently with this Response. As the Terminal Disclaimer renders the double patenting rejection moot, Applicants respectfully request its withdrawal.

III. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner maintained the rejection of claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because allegedly the "claims are directed to composition comprising polymers which are solely defined by physical properties." Final Office Action, pages 3, 4 and 6. Further, the Examiner alleged that "a screen method for finding a compound is not a proper written description for the compound." *Id.* at page 6

(citing *Univ. of Rochester v. G.D. Searl & Co.* 358 F.3d 916, 920-23, 69 USPQ2d 1886, 1894-95 (Fed. Cir. 2004)). Applicants respectfully disagree with the Examiner and traverse this rejection for the reasons of record and the following additional reasons.

The facts and holding of the *University of Rochester* case do not apply here. In *University of Rochester*, the claims at issue contain functional language of the compound, i.e., “a non-steroidal compound that selectively inhibits activity of the PGHS-2 gene product,” and the specification did not disclose any such compound. *Univ. of Rochester*, 358 F.3d at 918, 920, 69 USPQ2d at 1888-89, 1895. The court thus held that, as the claimed methods “cannot be practiced based on the patent’s specification, even considering the knowledge of one skilled in the art,” the claims are invalid for failing to comply with the written description requirement. *Id.*, 358 F.3d at 920, 69 USPQ2d at 1895.

Here, as the Examiner admits, “‘tacky’, T_g , F_{max} , or $Es_{(M/V)}$ etc.” recited in the rejected claims are physical properties, but not functional limitations. See Final Office Action, page 3. In addition, and different from the *University of Rochester* case, the as-filed original specification provides embodiments of the “tacky polymer” as presently claimed, such as branched sulphonic polymers or (meth)acrylic ester polymers on page 6, lines 21-23, guidance on how to form the branched sulphonic polyester and the (meth)acrylic ester, and specific examples thereof on page 7, lines 5 - page 12, line 16. The present specification on pages 4-6 also provides guidance on how to determine the maximum peeling force F_{max} and the energy for separation $Es_{(M/V)}$, which are physical properties of the “tacky polymer” as presently claimed.

Therefore, Applicants respectfully submit one of ordinary skill in the art would recognize that the inventors had possession of the claimed invention at the time of filing. Accordingly, this rejection is improper. Applicants respectfully request that this rejection be withdrawn.

IV. REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner maintained the rejection of claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 103 over *Lee* in view of WO 95/18191 to Miller et al. ("*Miller*") for the reasons of record. Final Office Action, pages 4-7. Applicants continue to disagree with the Examiner and traverse this rejection for the reasons of record and the following additional reasons.

The Examiner alleges "in this case, Miller reference is reasonably pertinent to the particular problem with which the applicants were concerned." Office Action, page 7. Applicants respectfully disagree and point to *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992), which states that "a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."

Miller is directed to hot-melt adhesive compositions that are repulpable, that is, adhesive compositions that do not impede the recycling of paper products, nonwoven assemblies, and other disposable products to which the compositions are applied. (*Miller*, page 2, lines 5-7.) Required properties for such adhesives are said to include "high bond strength under conditions of shock, stress, high humidity, and extremes of temperature encountered in transportation and storage." (*Id.* at page 2, lines 15-17.)

In contrast, Applicants were searching for a cosmetic composition appropriate for use on keratinous fibers such as hair. In particular, Applicants desired a hairstyling composition having “good cosmetic properties, in particular in terms of disentanglement, softness and feel.” Specification, page 3, lines 8-19. Applicants respectfully submit that the adhesive compositions according to *Miller* having “high bond strength under conditions of shock, stress,” would not have logically commended themselves for use in cosmetic compositions that require good “disentanglement, softness, and feel.”

Miller, a reference directed to adhesives for paper and other packaging materials, is neither in the field of Applicants’ invention, nor does it provide an adequate solution to the particular problem with which Applicants were concerned. As such, *Miller* would not logically have commended itself to Applicants’ attention and cannot be considered analogous art to the present application.

Miller also cannot be considered analogous art to *Lee*, which is directed to hairspray compositions. According to *Lee*, “hairspray compositions must meet a number of functional requirements” which include “good holding ability and curl retention without giving a harsh, brittle feeling,” “low stickiness,” and “good combing characteristics.” *Lee* at 2. Because of the divergent properties highlighted above, the adhesive compositions according to *Miller* would not have logically commended themselves for use in hairspray compositions according to *Lee*. Since *Miller* is neither in the field of *Lee*’s invention, nor does it provide an adequate solution to the particular problem with which *Lee* is concerned, *Miller* cannot be considered analogous art to *Lee*.

Therefore, this rejection is improper and Applicants respectfully request it be withdrawn.

V. CONCLUSION


In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 27, 2007

By: 
Mark D. Sweet
Reg. No. 41,469

Attachments: Terminal Disclaimer